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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,847

11/30/2005

Fyodor Urnov

8325-0034 (S34-US1)

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EXAMINER

SISSON, BRADLEY L

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

04/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/533,847</p>	<p>Applicant(s) URNOV ET AL.</p>	
	<p>Examiner Bradley L. Sisson</p>	<p>Art Unit 1634</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2-5.
Claim(s) withdrawn from consideration: 1 and 6-15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: The replacement drawings filed 30 March 2009 are accepted.

/Bradley L. Sisson/
Primary Examiner
Art Unit: 1634

Continuation of 11. does NOT place the application in condition for allowance because:

At pages 7-8 of the response submitted 30 March 2009, hereinafter the response, applicant asserts: "The pending claims are drawn to polynucleotide-including arrays in which the polynucleotides consist only of sequences corresponding to accessible regions of cellular chromatin" while the nucleic acids on the array disclosed by US Patent 6,153,379 (Caskey) are not limited to just those "sequences corresponding to accessible regions."

This argument has been considered and has not been found persuasive. For convenience, claim 2, the sole independent claim under consideration, is reproduced below in part:

"(a) the polynucleotide sequences consist of polynucleotide sequences corresponding to accessible regions of cellular chromatin and are isolated based on their altered reactivity to a probe of chromatin structure as compared to reactivity of bulk chromatin with the probe, wherein the polynucleotide sequences are at least 25 nucleotides in length."

A review of the disclosure fails to find a definition for what constitutes the metes and bounds of the expression "corresponding to accessible regions." In the absence of a specific definition, the clause has been construed as allowing for nucleic acids that have differences in the nucleotide sequence, e.g., members of the array may be considered to "correspond" of any nucleotide sequence found in any life form wherein the array member has any percentage of identical nucleotide sequence.

It is further noted that the "accessible regions of cellular chromatin" are not limited to just those sequences naturally found in any gene, much less any particular life form, but fairly encompass any mutated gene as well as any nucleic acid that may have been inserted into chromatin via any vector, such as used in gene therapy, or in the screening of potentially useful sequences.

In view of this expansive interpretation of the claimed array and in the absence of convincing evidence to the contrary, the members that the array is comprised of could well have virtually any and all possible nucleotide sequences. Accordingly, and in the absence of convincing evidence to the contrary, the rejection is maintained.